

REMARKS

New claim 178 is a substantial copy of allowed claim 36 of the pending Yeates et al U.S. Application Serial No. 11/215,267, filed August 30, 2005. This Serial No. 11/215,267 will be referred to hereinafter as the “Yeates ‘267 application”, and this claim 36 will be referred to hereinafter as “Yeates claim 36.”

New claim 179 is a substantial copy of allowed claim 70 of the Yeates ‘267 application. This claim 70 will be referred to hereinafter as “Yeates claim 70.”

New claims 178 and 179 are being added to the present application to claim subject matter which interferes with the claims of the Yeates ‘267 application.

The claims previously pending in this application have been cancelled. Upon entry of this amendment the pending claims will be claims 178 and 179.

Support for newly added claims 178 and 179 is discussed below, pursuant to 37 CFR §§ 41.202(a)(5) and 41.202(a)(6), wherein it is demonstrated that applicants have written description support for claims 178 and 179 and have constructively reduced the inventions of these claims to practice.

I. Interference Rules for Suggesting an Interference

37 CFR § 41.202 sets forth the requirements for an Applicant suggesting an interference between an application and another application or patent. Specifically 37 CFR § 41.202 requires a suggestion for interference to:

- (1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,
- (2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

- (3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),
- (4) Explain in detail why the applicant will prevail on priority,
- (5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and
- (6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

II. 37 CFR § 41.202(a)(1) – Identification of Application

As indicated above, applicants request declaration of an interference between the present application and the Yeates '267 application.

III. 37 CFR § 41.202(a)(2) – Identification of Interfering Claims, Proposed Count, and Claim Correspondence

A. Identification of Interfering Claims

New claim 178 interferes with Yeates claim 36, and new claim 179 interferes with Yeates claim 70. The standard for determining whether claims interfere with one another is found in 37 C.F.R. § 41.203(a), which states:

An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

The subject matter of new claim 178 would anticipate or render obvious the subject matter of Yeates claim 36 and vice versa. Similarly, new claim 179 interferes with Yeates claim

70, because the subject matter of new claim 179 would anticipate or render obvious the subject matter of Yeates claim 70 and vice versa.

B. Proposed Count

The Count proposed herein recites, in the alternative:

The process of claim 179 of U.S. Application Serial No. 10/573,694

OR

The process of claim 70 of U.S. Application Serial No. 11/215,267.

C. Correspondence of Claims to Proposed Count

According to 37 CFR § 41.207(b)(2), a claim corresponds to a Count if the subject matter of the Count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

The claims of the parties that are believed to correspond to the proposed Count are as follows:

Yeates '267 application (Yeates *et al*): Claims 36-43 and 63-73

The present application (Serafin *et al*): Claims 178 and 179

The claims of the parties that are believed to not correspond to the proposed Count are as follows:

Yeates '267 application (Yeates *et al*): none

The present application (Serafin *et al*): none

An explanation of why all of the claims of the parties correspond to the proposed Count is provided in Section VII below.

IV. 37 CFR § 41.202(a)(3) – Showing that Claims Interfere**A. New Claim 178 Interferes with Yeates Claim 36**

Although new claim 178 is worded in a slightly different manner than claim 36 of the Yeates '267 application, these claims are not patentably distinct from one another. A claim chart, pursuant to 37 CFR § 41.202(a)(3), comparing the present claim 178 to Yeates claim 36, is provided as follows:

Claim 178	Claim 36 of the Yeates '267 Application
A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating fluoride anions and zirconium silicate into alumina;	A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating a fluoride-containing species and a strength enhancing additive into a carrier . . . wherein the strength enhancing additive is selected from the group consisting of a zirconium species, a lanthanide Group species, inorganic glass, and mixtures thereof.
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	calcining the carrier at a temperature of from greater than about 900 °C to less than 1200 °C; and
subsequently depositing a catalytic species comprising silver onto the carrier.	subsequently depositing a catalytic species onto the carrier.

In the discussion below, it is explained why any differences in wording do not create patentable distinction between the claims of the parties.

1. The Preamble of the Interfering Claims

The preambles of the respective claims (i.e. new claim 178 and claim 36 of the Yeates '267 application) are the same, reciting:

A process for preparing a catalyst for the epoxidation of an olefin comprising . . .

2. The First Step of the Interfering Claims – Catalyst Precursor

The first step of new claim 178 and the first step of Yeates claim 36 call for the incorporation of a fluoride species and a zirconium species onto a support. A side-by-side comparison of the first step of the respective claims is provided in the following chart:

Claim 178	Claim 36 of the Yeates '267 Application
incorporating fluoride anions and zirconium silicate into alumina;	incorporating a fluoride-containing species and a strength enhancing additive into a carrier . . . wherein the strength enhancing additive is selected from the group consisting of a zirconium species, a lanthanide Group species, inorganic glass, and mixtures thereof.

There are three differences in the wording of this first step, as shown in the following chart:

Claim 178	Yeates Claim 36
The fluoride species is recited as “fluoride anions.”	The fluoride species is recited as “fluoride-containing species.”
The zirconium species is recited as “zirconium silicate.”	The zirconium species is recited as a strength enhancing additive which is a “zirconium species.”
The support is recited as “an alumina carrier.”	The support is recited as a “carrier.”

New claim 178 defines the same patentable invention as Yeates claim 36, even though the first step is worded differently in the respective claims.

a. The Fluoride-Containing Species of the Interfering Claims

New claim 178 recites the incorporation of “fluoride anions,” whereas claim 36 of the Yeates '267 application recites the incorporation of a “fluoride-containing species.” A “fluoride-containing species” includes “fluoride anions.”

At the time of the October 16, 2003, filing date of the present applicant's '975 provisional application, it was well known that fluoride anions, especially in the form of acidic

components having fluoride anions, such as ammonium fluoride, were used to form alpha-alumina. See Bhasin U.S. Patent No. 4,908,343 (of record in the Yeates '267 application) at column 23, line 31 to column 24, line 31. For example, at column 24, lines 10-13, of the Bhasin '343 patent, the preparation of carrier "G" is described as follows:

Carrier G is an alpha-alumina carrier prepared by calcining to a maximum temperature of about 1100° C., gamma alumina (N 6573) which had been impregnated with an aqueous 1M ammonium fluoride solution.

Therefore, the recitation in new claim 178 of "fluoride anions" anticipates or renders obvious the recitation in Yeates claim 36 of a "fluoride-containing species," and vice versa.

b. The Zirconium Species of the Interfering Claims

New claim 178 calls for incorporating "zirconium silicate," whereas the Yeates claim 36 calls for incorporating a strength enhancing additive into a carrier, wherein the strength enhancing additive may be a "zirconium species."

Zirconium silicate is a well known zirconium species. See Buffum U.S. Patent No. 5,145,824, e.g., at column 3, lines 10-18. Therefore, the recitation in new claim 178 of zirconium silicate anticipates the recitation in Yeates claim 36 of a zirconium species, and the recitation in Yeates claim 36 of a zirconium species renders obvious the recitation in new claim 178 of zirconium silicate.

It is noted that zirconium silicate is specifically listed as a strength enhancing additive in paragraph [0034] on page 3 of Patent Application Publication US 2006/0047130, which is the published counterpart of the Yeates '267 application. To the extent that zirconium silicate and other zirconium species enhance strength, the property of enhancing strength is an inherent property of zirconium silicate. The recitation of the property of strength enhancement in Yeates claim 36 does not render this claim separately patentable from new claim 178.

c. The Carrier of the Interfering Claims

At the time of the filing of applicants' provisional application on October 16, 2003, alumina was a well known carrier for catalysts for the manufacture of ethylene oxide. See the Bhasin '343 patent, especially at column 23, line 31 to column 24, line 31. Furthermore, it is noted that claim 38 of the Yeates '267 application states that the catalyst comprises alpha-alumina. Therefore, the recitation in new claim 178 of alumina anticipates the recitation in Yeates claim 36 of a carrier, and the recitation in Yeates claim 36 of a carrier renders obvious the recitation in new claim 178 of alumina.

3. The Second Step of the Interfering Claims - Calcination

The second step of new claim 178 involves calcination. A side-by-side comparison of the second step of the respective claims is provided in the following chart:

Claim 178	Claim 36 of the Yeates '267 Application
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	calcining the carrier at a temperature of from greater than about 900 °C to less than 1200 °C; and

The second step of new claim 178 is worded differently than the second step of Yeates claim 36. However, this difference in wording does not create a patentable distinction between the present claim 178 and Yeates claim 36.

New claim 178 calls for calcining the carrier precursor at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina, whereas the Yeates claim 36 calls for calcining the carrier at a temperature of from greater than about 900 °C to less than 1200 °C. As stated in the above-quoted passage of the Bhasin patent at column 24, lines 10-13, alpha-alumina can be produced by calcination of an alpha-alumina precursor (i.e. gamma alumina) to a temperature of about 1100° C. It is noted that claim 38 of the Yeates '267 application,

specifically, calls for the carrier to be alpha-alumina. Therefore, the recitation in new claim 178, which calls for calcining the carrier precursor at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina, renders obvious the Yeates claim 36 recitation, which calls for calcining the carrier at a temperature of from greater than about 900 °C to less than 1200 °C and vice versa. Furthermore, the overlapping temperature ranges recited in the respective claims render the claims obvious in view of one another. MPEP 2144.05.

4. The Final Step of the Interfering Claims – Catalyst Component

The final step of new claim 178 involves deposition of a catalyst component onto a carrier. A side-by-side comparison of the final step of the respective claims is provided in the following chart:

Claim 178	Claim 36 of the Yeates '267 Application
subsequently depositing a catalytic species comprising silver onto the carrier.	subsequently depositing a catalytic species onto the carrier.

The final step of new claim 178 is worded in a slightly different manner than the final step of Yeates claim 36.

New claim 178 recites that, after calcination, a catalytic species comprising “silver” is subsequently deposited onto the carrier, whereas Yeates claim 36 recites that, after calcination, a “catalytic species” is subsequently deposited onto the carrier. Silver is a well known catalytic species for the manufacture of ethylene oxide. See the Abstract of the Bhasin '343 patent. Furthermore, it is noted that claim 40 of the Yeates '267 application specifically recites that the catalytic species is silver. Therefore, the recitation of new claim 178, stating that a catalytic species comprising silver is subsequently deposited onto the carrier, anticipates the recitation in Yeates claim 36, stating that a catalytic species is subsequently deposited onto the carrier, and the recitation in Yeates claim 36, stating that a catalytic species is subsequently deposited onto

the carrier, renders obvious the recitation of new claim 178, stating that a catalytic species comprising silver is subsequently deposited onto the carrier.

B. New Claim 179 Interferes With Yeates Claim 70

The only difference between claim 178 and claim 179, resides in the wording of the final deposition step, whereby claim 179 recites the deposition of a **rhenium component** onto the carrier. A side-by-side comparison of this final step is shown in the following chart:

Claim 178	Claim 179
subsequently depositing a catalytic species comprising silver onto the carrier.	subsequently depositing silver and rhenium component onto the carrier.

A claim chart, pursuant to 37 CFR § 41.202(a)(3), comparing the present claim 179 to Yeates claim 70, is provided as follows:

Claim 179	Claim 70 of the Yeates '267 Application
A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating fluoride anions and zirconium silicate into alumina;	A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating a fluoride-containing species and a strength enhancing additive into a carrier . . . wherein the strength enhancing additive is selected from the group consisting of a zirconium species, a lanthanide Group species, a calcium species, a magnesium species, inorganic glass, and mixtures thereof.
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	calcining the carrier at a temperature of from greater than about 900 °C to less than 1200 °C; and
subsequently depositing a catalytic species comprising silver and rhenium component onto the carrier.	subsequently depositing silver and a rhenium component onto the carrier.

V. 37 CFR § 41.202(a)(4) – Explanation of Why Applicants will Prevail on Priority

The present applicants constructively reduced the invention of the Count to practice before Yeates *et al.*

The present application claims the benefit of Provisional Application No. 60/511,975, filed October 16, 2003. The present application is, in fact, entitled to the benefit of the '975 provisional application for the purposes of newly added claims 178 and 179.

The Yeates '267 application claims the benefit of Provisional Application No. 60/606,193, filed September 1, 2004.

Accordingly, in an interference between the present application and the Yeates '267 application, the present applicant would be senior party and *prima facie* entitled to priority over Yeates *et al.*

VI. 37 CFR §§ 41.202(a)(5) and 41.202(a)(6) – Showing Written Description and Constructive Reductions to Practice for Claims 178 and 179

New claim 178 is fully supported by both (1) the present U.S. Application Serial No. 10/573,694, and (2) the '975 provisional application, filed October 16, 2003.

A. The Present '694 Application Supports New Claim 178

Examples of passages of the present application, which support newly added claim 178, are provided in the following claim chart pursuant to 37 CFR § 41.202(a)(5):

Claim 178	The Present Application (USSN 10/573,694)
A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating fluoride anions and zirconium silicate into alumina;	This invention relates to catalysts for the epoxidation of alkenes . . . (page 1, line 11) . . . by incorporating sufficient amount of zirconium component substantially as zirconium silicate. (page 1, lines 13-14) Another method for preparing the carrier . . . comprises mixing zirconium silicate with boehmite alumina (AlOOH) and/or gamma-alumina, peptizing the aluminas with a mixture containing an acidic component and halide anions (preferably fluoride anions) to provide peptized halogenated alumina . . . (page 7, lines 27-30)
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	. . . drying the formed peptized halogenated alumina to provide dried formed alumina, and calcining the dried formed alumina to provide pills of modified alpha-alumina carrier. (page 7, lines 32-34) After drying, the extruded greenware was fired to alpha-alumina under conditions chosen to ensure complete conversion of the extrudates to alpha-alumina. Firing temperatures between 1000°C and 1400°C and firing times from 45 minutes to 5 hours were used. (page 18, lines 29-31)
subsequently depositing a catalytic species comprising silver onto the carrier.	Catalysts for the production of alkylene oxide . . . may be prepared . . . by impregnating the carrier with a solution of one or more silver compounds . . . (page 8, lines 30-32)

It is noted that the preamble of claim 178 recites an “olefin,” whereas the passage on page 1, line 11, of the present ‘694 application refers to “alkenes.” However, this difference in terminology is not a distinction, because the term “olefin” is synonymous with the term “alkene.”

B. The '975 Provisional Application Supports New Claim 178

Provisional application No. 60/511,975, filed October 16, 2003, to which the present application claims benefit, also supports new claim 178. The same passages, which support claim 178 in the present application, are also essentially included in the '975 provisional application, as demonstrated by the following claim chart pursuant to 37 CFR § 41.202(a)(5):

Claim 178	Applicant's Provisional Application (USSN 60/511,975)
A process for preparing a catalyst for the epoxidation of an olefin comprising: incorporating fluoride anions and zirconium silicate into alumina;	This invention relates to catalysts for the epoxidation of alkenes . . . (page 1, line 4) . . . by incorporating sufficient amount of zirconium component substantially as zirconium silicate. (page 1, lines 6-7) One method for preparing a carrier . . . comprises mixing zirconium silicate with boehmite alumina (AlOOH) and /or gamma-alumina, peptizing the aluminas with a mixture containing an acidic component and halide anions (preferably fluoride anions) to provide peptized halogenated alumina . . . (page 8, lines 15-19)
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	. . . drying the formed halogenated alumina to provide dried formed alumina, and calcining the dried formed alumina to provide pills of modified alpha-alumina carrier. (page 8, lines 20-22) After drying, the extruded greenware was fired to alpha-alumina. A firing temperature between 1000°C and 1400°C and a firing time of 45 minutes to 5 hours was used to ensure complete conversion of the extrudates to alpha-alumina. (page 20, line 28 to page 21, line 1)
subsequently depositing a catalytic species comprising silver onto the carrier.	Catalysts for the production of alkylene oxide . . . may be prepared . . . by impregnating the carrier with a solution of one or more silver compounds . . . (page 10, lines 10-12)

C. New Claim 179 Is Also Supported by both the Present '694 Application and the '975 Provisional Application

The only difference between claim 178 and claim 179, resides in the wording of the final deposition step, whereby claim 179 recites the deposition of a **rhenium component** onto the carrier. A side-by-side comparison of this final step is shown in the following table:

Claim 178	Claim 179
subsequently depositing a catalytic species comprising silver onto the carrier.	subsequently depositing silver and rhenium component onto the carrier.

Support for the recitation in claim 179 of depositing a rhenium component onto the carrier may be found in the present '694 application (USSN 10/573,694) at page 9, lines 24-33; page 13, lines 19-30; and in claim 9 on page 27. Support for this recitation of depositing a rhenium component may also be found in applicants' '975 provisional application (USSN 60/511,975) at page 11, lines 10-24; page 15, lines 15-28; and in claim 9 on page 29. Thus, new claim 179 is entitled to an effective filing date of October 16, 2003.

A claim chart pursuant to 37 CFR § 41.202(a)(5), comparing claim 179 with the disclosure of the present '694 application, is provided as follows:

Claim 179	The Present Application (U.S.S.N. 10/573,694)
<p>A process for preparing a catalyst for the epoxidation of an olefin comprising:</p> <p>incorporating fluoride anions and zirconium silicate into alumina;</p>	<p>This invention relates to catalysts for the epoxidation of alkenes . . . (page 1, line 11)</p> <p>. . . by incorporating sufficient amount of zirconium component substantially as zirconium silicate. (page 1, lines 13-14)</p> <p>Another method for preparing the carrier . . . comprises mixing zirconium silicate with boehmite alumina (AlOOH) and/or gamma-alumina, peptizing the aluminas with a mixture containing an acidic component and halide anions (preferably fluoride anions) to provide peptized halogenated alumina . . . (page 7, lines 27-30)</p>
<p>calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and</p>	<p>. . . drying the formed peptized halogenated alumina to provide dried formed alumina, and calcining the dried formed alumina to provide pills of modified alpha-alumina carrier. (page 7, lines 32-34)</p> <p>After drying, the extruded greenware was fired to alpha-alumina under conditions chosen to ensure complete conversion of the extrudates to alpha-alumina. Firing temperatures between 1000°C and 1400°C and firing times from 45 minutes to 5 hours were used. (page 18, lines 29-31)</p>
<p>subsequently depositing silver and rhenium component onto the carrier.</p>	<p>Catalysts for the production of alkylene oxide . . . may be prepared . . . by impregnating the carrier with a solution of one or more silver compounds . . . (page 8, lines 30-32)</p> <p>The catalyst of claim 1 wherein at least one of the efficiency-enhancing promoters is a rhenium component. (page 27, claim 9)</p>

A claim chart pursuant to 37 CFR § 41.202(a)(5), comparing claim 179 with the disclosure of the '975 provisional application, is provided as follows:

Claim 179	Applicant's Provisional Application (USSN 60/511,975)
A process for preparing a catalyst for the epoxidation of an olefin comprising:	This invention relates to catalysts for the epoxidation of alkenes . . . (page 1, line 4)
incorporating fluoride anions and zirconium silicate into alumina;	. . . by incorporating sufficient amount of zirconium component substantially as zirconium silicate. (page 1, lines 6-7) One method for preparing a carrier . . . comprises mixing zirconium silicate with boehmite alumina (AlOOH) and /or gamma-alumina, peptizing the aluminas with a mixture containing an acidic component and halide anions (preferably fluoride anions) to provide peptized halogenated alumina . . . (page 8, lines 15-19)
calcining the alumina at a temperature between 1000°C and 1400°C to form a carrier comprising alpha-alumina; and	. . . drying the formed halogenated alumina to provide dried formed alumina, and calcining the dried formed alumina to provide pills of modified alpha-alumina carrier. (page 8, lines 20-22) After drying, the extruded greenware was fired to alpha-alumina. A firing temperature between 1000°C and 1400°C and a firing time of 45 minutes to 5 hours was used to ensure complete conversion of the extrudates to alpha-alumina. (page 20, line 28 to page 21, line 1)
subsequently depositing a catalytic species comprising silver and rhenium component onto the carrier.	Catalysts for the production of alkylene oxide . . . may be prepared . . . by impregnating the carrier with a solution of one or more silver compounds . . . (page 10, lines 10-12) The catalyst of claim 1 wherein at least one of the efficiency-enhancing promoters is a rhenium component. (page 29, claim 9)

VII. Explanation of Why All of the Parties Claims Correspond to the Proposed Count

As stated above, according to 37 CFR § 41.202(b)(2), a claim corresponds to a Count if the subject matter of the Count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

A. All of the Claims of the Yeates '267 Application Correspond to the Count

1. Yeates Claim 36

Yeates claim 36 recites that a catalytic species is deposited on a carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that silver and a rhenium component are deposited onto a carrier. Silver is a well known catalytic species for the manufacture of ethylene oxide. See the Abstract of the Bhasin '343 patent. Furthermore, it is noted that claim 40 of the Yeates '267 application, which depends from Yeates claim 36, specifically recites that the catalytic species is silver. Therefore, the recitation of the Count, stating that a catalytic species comprising silver is subsequently deposited onto the carrier, anticipates the recitation in Yeates claim 36, stating that a catalytic species is subsequently deposited onto the carrier.

Yeates claim 36 does not exclude the deposition of a rhenium component onto the carrier. Rather, Yeates claim 43, which depends from Yeates claim 36, specifically recites a rhenium component.

Both Yeates claim 36 and the Count recite that the strength enhancing additive may be a zirconium species, a lanthanide Group species, inorganic glass, and mixtures thereof. The Count, particularly the alternative part thereof including Yeates claim 70, further recites that the strength enhancing additive may be a calcium species or a magnesium species.

Therefore, the Count anticipates Yeates claim 36, and Yeates claim 36 should be designated as corresponding to the proposed Count.

2. Yeates Claim 37

Yeates claim 37 recites that the strength enhancing additive is cerium.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the strength enhancing may be a lanthanide Group species. Cerium is a well known lanthanide Group species. One of ordinary skill in the art, seeing a recitation of a lanthanide Group species would immediately envisage cerium.

Therefore, the Count anticipates or renders obvious Yeates claim 37, and Yeates claim 37 should be designated as corresponding to the proposed Count.

3. Yeates Claim 38

Yeates claim 38 recites that the carrier comprises alpha-alumina.

The Count, particularly the alternative part thereof including Yeates claim 70, recites a carrier, generically. Alpha-alumina is a well known carrier, especially for a catalyst for the epoxidation of an olefin. See the Bhasin '343 patent, especially the Abstract and at column 23, line 67 to column 24, line 31.

It is further noted that the alternative part of the proposed Count reciting the present claim 179, expressly recites an alpha-alumina carrier.

Therefore, the Count anticipates or renders obvious Yeates claim 38, and Yeates claim 39 should be designated as corresponding to the proposed Count.

4. Yeates Claim 39

Yeates claim 39 recites that the catalytic species comprises one or more of silver, molybdenum, nickel, and tungsten.

The Count, particularly the alternative part thereof including Yeates claim 70, recites silver.

Therefore, the Count anticipates Yeates claim 39, and Yeates claim 39 should be designated as corresponding to the proposed Count.

5. Yeates Claim 40

Yeates claim 40 recites that the catalytic species comprises silver.

The Count, particularly the alternative part thereof including Yeates claim 70, also recites silver.

Therefore, the Count anticipates Yeates claim 40, and Yeates claim 40 should be designated as corresponding to the proposed Count.

6. Yeates Claim 41

Yeates claim 41 recites that the process additionally includes depositing a high selectivity dopant onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the catalyst comprises a rhenium component. A rhenium component is a high selectivity dopant, as described in the Yeates '267 application.

Therefore, the Count anticipates or renders obvious Yeates claim 41, and Yeates claim 41 should be designated as corresponding to the proposed Count.

7. Yeates Claim 42

Yeates claim 42 recites that the process additionally comprises depositing a Group IA metal component onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, generically encompasses the deposition of a Group IA metal (i.e. alkali metal) component onto the carrier. It

is well known to deposit a Group IA metal component onto the carrier, especially for a catalyst for the epoxidation of an olefin. See the Bhasin '343 patent, especially at column 17, lines 21-29; and Chipman et al WO 2003/044003 at claim 13 and at page 20, lines 3-27.

Therefore, the Count anticipates or renders obvious Yeates claim 42, and Yeates claim 42 should be designated as corresponding to the proposed Count.

8. Yeates Claim 43

Yeates claim 43 recites that the process additionally comprises depositing a rhenium component, or a rhenium component and a rhenium co-promoter onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the catalyst comprises a rhenium component.

Therefore, the Count anticipates or renders obvious Yeates claim 43, and Yeates claim 43 should be designated as corresponding to the proposed Count.

9. Yeates Claim 63

Yeates claim 63 recites the process of Yeates claim 36, except that Yeates claim 63 recites incorporating cerium into a carrier before calcination, without specifically characterizing cerium as being a "strength enhancing additive."

The Count, particularly the alternative part thereof including Yeates claim 36, recites that the strength enhancing may be a lanthanide Group species. Cerium is a well known lanthanide Group species. One of ordinary skill in the art, seeing a recitation of a lanthanide Group species would immediately envisage cerium.

Therefore, the Count anticipates or renders obvious Yeates claim 63, and Yeates claim 63 should be designated as corresponding to the proposed Count.

10. Yeates Claim 64

Yeates claim 64 recites that the carrier comprises alpha-alumina.

The Count, particularly the alternative part thereof including Yeates claim 70, recites a carrier, generically. Alpha-alumina is a well known carrier, especially for a catalyst for the epoxidation of an olefin. See the Bhasin '343 patent, especially at column 23, line 31 to column 24, line 31.

It is further noted that the alternative part of the proposed Count reciting the present claim 179, expressly recites an alpha-alumina carrier.

Therefore, the Count anticipates or renders obvious Yeates claim 64, and Yeates claim 64 should be designated as corresponding to the proposed Count.

11. Yeates Claim 65

Yeates claim 65 recites that the catalytic species comprises one or more of silver, molybdenum, nickel, and tungsten.

The Count, particularly the alternative part thereof including Yeates claim 70, recites silver.

Therefore, the Count anticipates Yeates claim 65, and Yeates claim 65 should be designated as corresponding to the proposed Count.

12. Yeates Claim 66

Yeates claim 66 recites that the catalytic species comprises silver.

The Count, particularly the alternative part thereof including Yeates claim 70, recites silver.

Therefore, the Count anticipates or renders obvious Yeates claim 66, and Yeates claim 66 should be designated as corresponding to the proposed Count.

13. Yeates Claim 67

Yeates claim 67 recites that the process additionally recites depositing a high selectivity dopant onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the catalyst comprises a rhenium component. A rhenium component is a high selectivity dopant, as described in the Yeates '267 application.

Therefore, the Count anticipates or renders obvious Yeates claim 67, and Yeates claim 67 should be designated as corresponding to the proposed Count.

14. Yeates Claim 68

Yeates claim 68 recites that the process additionally comprises depositing a Group IA metal component onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, generically encompasses the deposition of a Group IA metal (i.e. alkali metal) component onto the carrier. It is well known to deposit a Group IA metal component onto the carrier, especially for a catalyst for the epoxidation of an olefin. See the Bhasin '343 patent, especially at column 17, lines 21-29; and Chipman et al WO 2003/044003 at claim 13 and at page 20, lines 3-27.

Therefore, the Count anticipates or renders obvious Yeates claim 68, and Yeates claim 68 should be designated as corresponding to the proposed Count.

15. Yeates Claim 69

Yeates claim 69 recites that the process additionally comprises depositing a rhenium component, or a rhenium component and a rhenium co-promoter onto the carrier. See Chipman et al WO 2003/044003 at claim 13 and at page 20, lines 3-27.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the catalyst comprises a rhenium component.

Therefore, the Count anticipates or renders obvious Yeates claim 69, and Yeates claim 69 should be designated as corresponding to the proposed Count.

16. Yeates Claim 70

Yeates claim 70 is an alternative part of the proposed Count. Therefore, the Count anticipates Yeates claim 70, and Yeates claim 70 should be designated as corresponding to the proposed Count.

17. Yeates Claim 71

Yeates claim 71 recites that the strength enhancing additive is cerium.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the strength enhancing may be a lanthanide Group species. Cerium is a well known lanthanide Group species. One of ordinary skill in the art, seeing a recitation of a lanthanide Group species would immediately envisage cerium.

Therefore, the Count anticipates or renders obvious Yeates claim 71, and Yeates claim 71 should be designated as corresponding to the proposed Count.

18. Yeates Claim 72

Yeates claim 72 recites that the carrier comprises alpha-alumina.

The Count, particularly the alternative part thereof including Yeates claim 70, recites a carrier, generically. Alpha-alumina is a well known carrier, especially for a catalyst for the epoxidation of an olefin. See the Bhasin '343 patent, especially at column 23, line 67 to column 24, line 31.

It is further noted that the alternative part of the proposed Count reciting the present claim 179, expressly recites an alpha-alumina carrier.

Therefore, the Count anticipates or renders obvious Yeates claim 72, and Yeates claim 72 should be designated as corresponding to the proposed Count.

19. Yeates Claim 73

Yeates claim 73 recites that the process additionally recites depositing a high selectivity dopant onto the carrier.

The Count, particularly the alternative part thereof including Yeates claim 70, recites that the catalyst comprises a rhenium component. A rhenium component is a high selectivity dopant, as described in the Yeates '267 application.

Therefore, the Count anticipates or renders obvious Yeates claim 73, and Yeates claim 73 should be designated as corresponding to the proposed Count.

B. All of the Claims of the Present '694 Application Correspond to the Count

1. The Present Claim 178

Both the present claim 178 and the Count, particularly the alternative part thereof including the present claim 179, recite silver.

Therefore, the Count anticipates Yeates claim 178, and Yeates claim 178 should be designated as corresponding to the proposed Count.

2. The Present Claim 179

The present claim 179 is an alternative part of the proposed Count. Therefore, the Count anticipates Yeates claim 179, and Yeates claim 179 should be designated as corresponding to the proposed Count.

VIII. Declaration of an Interference is Appropriate Under 35 USC § 135(b)

An interference will not be declared under certain situations described in 35 USC § 135(b). None of those situations apply to the interference presently suggested.

35 USC § 135(b)(1) states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 USC § 135(b)(1) does not apply, because the claims of the Yeates '267 have not yet issued in a patent.

35 USC § 135(b)(2) states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

35 USC § 135(b)(2) does not apply for a number of reasons. First, the present application was pending when the Yeates '267 application published. Second, the published claims in the Yeates published application were copied into the present '694 application. Third, the allowed claims of the Yeates '267 application are different from the claims in the Yeates published application.

Accordingly, 35 USC § 135(b) does not bar the declaration of the presently suggested interference.

IX. Yeates Claims have been Allowed

In the Yeates '267 application, Examiner David E. Gallis of Group Art Unit 1625 has allowed all of Yeates claims 36-43 and 63-73. The Notice of Allowance was mailed on May 15, 2009.

X. Assignment of Interfering Applications to an Examiner

The assignment of applications that are believed to interfere is discussed in MPEP

2304.01(b). First it is stated:

Ordinarily applications that are believed to interfere should be assigned to the same examiner.

Then, in MPEP 2304.01(b), it is stated:

If the interference would be between two applications, and the applications are assigned to different Technology Centers (TCs), then one application must be reassigned. Ordinarily the applications should both be assigned to the TC where the commonly claimed invention would be classified. After termination of the interference, further transfer may be appropriate depending on the outcome of the interference.

The present '694 application and the Yeates '267 application are currently being examined by different Examiners in different Technology Centers (TCs).

The Examiner of the present '694 application is Anthony J. Zimmer of TC 1700 (Art Unit 1793).

The Examiner of the Yeates '267 application is David E. Gallis of TC 1600 (Art Unit 1625).

Since Examiner Gallis has already examined the subject matter of the present claims, searched the prior art and found this subject matter to be allowable, it is appropriate that the present application is transferred to Examiner Gallis.

Accordingly, it is respectfully requested that the present '694 application is transferred to Examiner Gallis.

XI. Consultation with an Interference Practice Specialist

The Examiner is respectfully requested to consult with an appropriate interference practice specialist (IPS) as soon as possible. Such consultation is described in MPEP 2302, wherein it is stated:

Less than one percent of all applications become involved in an interference. Consequently, examiners are not expected to become experts in interference practices. Instead, examiners are expected to be proficient in identifying potential interference and to consult with an IPS in their TC on interference matters. The IPS, in turn, is knowledgeable about when and how to suggest interferences, how to handle inquiries to and from the Board and during interferences, and how to handle applications after interferences are completed.

In MPEP 2302, it is further stated:

In an effort to maximize uniformity, when an examiner first becomes aware that a potential interference exists or any other interference issue arises during prosecution of an application, the examiner should bring the matter to the attention of an IPS in the examiner's TC.

In the USPTO website, under the page for the Board of Patent Appeals and Interferences, interference practice specialists are listed. For TC 1700, the IPSs are listed as William Krynski (x21024) and Christine Skane Tierney (x21055). For TC 1600, the IPSs are listed as Larry Helm (x20832), Cecilia Tsang (x20562) and Joe Weitach (x20739).

XII. Issuance of the Present Application before the Yeates Application may be Appropriate

The present application has an effective filing date which is more than six months earlier than the earliest effective filing date of the Yeates '267 application.

As stated in MPEP 2302:

If the applications are both in condition for allowance and earliest effective filing dates of the applications are not within six months of each other, the application with the earliest effective filing date shall be issued. The application with the later filing date shall be rejected on the basis of the application with the earliest effective filing date. Further action in the application with the later filing date will be governed by prosecution in that application. If the applicant in the

application with the later filing date makes the showing required by 37 CFR 41.202(d), an application versus patent interference may be declared. If no rejection is possible over the patent issuing from the application with the earliest effective filing date, then the application must still be required under 35 U.S.C. 132 to make the priority showing required in 37 CFR 41.202(d).

As noted above, Yeates claims 36 and 70 have been allowed. The present claims 178 and 179 are directed to the substantially the same subject matter as Yeates claims 36 and 70.

XIII. Form PTO-850

Attached hereto is a proposed, partially completed Form PTO-850. The section of the attached Form PTO-850, pertaining to the Application No. and Filing Date of the proposed priority benefit date of the Junior Party Yeates et al, has not been filled in. Instead, these spaces have been marked:

(To be completed by Examiner or IPS).

There are two possible applications which could be inserted in these benefit sections of a Form PTO-850. One application is the proposed involved Yeates '267 application, filed August 30, 2005 (08/30/05). The other application is the Yeates provisional Application Serial No. 60/606,193, filed September 1, 2004 (09/01/04). The Yeates '267 application claims benefit of the Yeates '193 provisional application.

Applicants' submit that the Examiner or an IPS should make an independent evaluation of the Yeates '193 provisional application to determine whether benefit to this application should be proposed in Form PTO-850. Applicants' reserve the right to challenge the benefit of Junior Party Yeates et al to the filing date of the '193 provisional application during the motions period of the interference suggested herein.

Whether or not the Junior Party is granted benefit of the '193 provisional application, Senior Party Serafin et al would remain Senior Party. For reasons given herein, the effective

filing date of the Senior Party Serafin et al is October 16, 2003. If the Junior Party Yeates et al is granted the benefit of the September 1, 2004 filing date of the '193 provisional application, Senior Party Serafin et al would be senior to Junior Party Yeates et al by over 10 months. If the Junior Party Yeates et al is denied the benefit of the '193 provisional application, the effective filing date of the Junior Party Yeates et al would be the August 30, 2005 filing date of the Yeates '267 application, and Senior Party Serafin et al would be senior to Junior Party Yeates et al by over 22 months.

XIV. Expedited Handling of the Present Application is Required

The Examiner is respectfully requested to act on the present suggestion for interference with special dispatch.

The present '694 application has special status and must be advanced out of turn for examination. This special status is discussed in MPEP 708.01, wherein it is stated that applications having such special status include:

Applications which appear to interfere with other applications previously considered and found allowable, or which will be placed in interference with an unexpired patent or patents.

Furthermore, the following is stated in MPEP 2301:

Given the infrequency, cost, and complexity of interferences, it is important for the examiner to consult immediately with an Interference Practice Specialist (IPS) in the examiner's Technology Center, see MPEP § 2302, once a possible interference is identified. It is also important to complete examination before the possible interference is referred to the Board. See MPEP § 2303.

XV. Conclusion

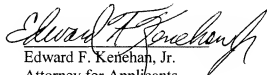
In view of the foregoing, the following are respectfully requested of the Examiner:

- (1) prompt allowance of the present '694 application;
- (2) immediate consultation with an Interference Practice Specialist;

- (3) expedited handling of the present interference suggestion, pursuant to MPEP 708.01 and MPEP 2301;
- (4) transfer of the present application to Examiner Gallis of Group Art Unit 1625; and
- (5) prompt declaration of an interference between the present '694 application and the Yeates '267 application as suggested herein.

Respectfully submitted,

Date: JUNE 5, 2009



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